

REMARKS

The present Amendment is in response to the Official Action mailed September 17, 2008. Claims 1, 5, 6, 9-11, 20, and 21 have been amended, claims 3, 4, and 14-19 have either been canceled herein or previously canceled. Thus, claims 1, 2, 5-13, 20, and 21 remain currently pending in the present case. The following sets forth Applicants' remarks pertaining to the currently pending claims and the outstanding Action.

As an initial matter, Applicants respectfully thank the Examiner for conducting the telephone interview of December 23, 2008, with regard to the present case, and two other related cases that the examiner is handling. Specifically, in that discussion, which is evidenced by the Examiner's Interview Summary dated January 13, 2009, the present case and U.S. Patent Application Serial Nos. 10/781,505 and 10/781,507 were discussed. In addition, it was brought to the Examiner's attention that at least one other case in the family of cases related to the present case includes similarly claimed subject matter (i.e., U.S. Patent Application Serial No. 10/781,504). Telephone discussions with the Examiner (i.e., Examiner Schillinger) handling that latter case were conducted on January 14 and 16, 2009. In an Information Disclosure Statement accompanying the present case, those cases, as well as prior art cited in connection with them, have been listed. Should the Examiner wish to review any prosecution documents pertaining to any of these cases, Applicants would be glad to provide copies of same. In the aforementioned telephone discussion, the Examiner indicated, at least initially, that such would not be necessary.

In the December 23rd telephone discussion, the outstanding Action was also discussed. Specifically, Applicants' undersigned counsel provided arguments as to why the insertion plate arrangement of the present invention was very different

from that of the prior art. Namely, Applicants' undersigned counsel explained to the Examiner that the element referred to by the Examiner as meeting the insertion plate limitation in U.S. Patent No. 6,425,920 to Hamada ("*Hamada*") operates in a very different fashion than the insertion plate of the present invention. In particular, the element referred to as an insertion plate in *Hamada* by the Examiner is a very different structure than that of the present invention which is for use in connection with a fusion implant, not a two-piece implant as in the present case. On the other hand, the present invention teaches its insertion plate 700 being coupled with mounting screw holes 509, 609 of the intervertebral disc replacement device of the present invention, thereby leaving bone screw holes 508a, 508b, 608a, 608b capable of receiving bone screws while the insertion plate is still coupled to the device. Moreover, insertion plate 700 is detachably coupled with an insertion handle 800, so as to allow for the construct made up of device 400 and insertion plate 700 to be manipulated by the handle when coupled and to stand alone when uncoupled. As is more specifically set forth in paragraph [0069] of the originally-filed specification of the present case, this provides the benefit of placing the two components of the intervertebral disc replacement device in a familiar fashion to the surgeon, i.e., similar to that of a spinal plate (an example of which is shown in Figs. 13a-13d). The Examiner agreed that this was indeed a significant difference between the present invention and that of *Hamada*, and indicated that claim amendments that more specifically capture these differences would likely overcome the rejections set forth in the Action. Moreover, Applicants' undersigned counsel provided arguments as to the particular structures that facilitate the detachable coupling of the insertion plate and the insertion handle in the

present invention. The Examiner suggested certain claim amendments, some of which have been made above.

Turning now to the substance of the Action, the Examiner rejected claims 1-3, 9, 10, 20, and 21 under 35 U.S.C. § 103(a) as being obvious over the combination of *Hamada* and U.S. Patent No. 5,314,477 to Marnay ("*Marnay*"). Essentially, the Examiner asserted that *Hamada* teaches an insertion device similar to the one of the present invention (the Examiner cited to Fig. 33 of *Hamada* for this proposition) and *Marnay* to teach the insertion of a two-piece implant. The Examiner further asserted that it would be obvious to one of ordinary skill in the art at the time of the present invention to use the insertion device of *Hamada* with the implant of *Marnay*. Further in the Action, the Examiner noted claims 4-8 and 11-13 as being objected to as being dependent upon a rejected base claim, but allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims. Applicants respectfully thank the Examiner for this indication, and note that certain of the above-made claim amendments reflect such subject matter.

Specifically, independent claim 1 has been amended to include the subject matter set forth in noted allowable claim 4. This includes certain of the subject matter set forth in dependent claim 3, as previously presented dependent claim 4 depended therefrom. Moreover, independent claim 20 has been amended to include certain of the subject matter set forth in dependent claim 6, namely, the inclusion of anti-rotational mechanisms for resisting rotation of the stem within the bore and thereby assisting in maintaining the relative positions of the insertion handle and the insertion plate (with the intervertebral disc replacement device attached thereto) when they are engaged. The benefit that this provides is an assurance to the surgeon that the insertion plate (along with the intervertebral disc replacement device) will not

inadvertently be turned during insertion. Finally, independent claim 21 has been amended to include certain of the subject matter of previously presented dependent claim 11. As each and every one of independent claims 1, 20, and 21 have been amended to include this allowable subject matter, Applicants respectfully submit that such claims constitute allowable subject matter.

Although not specifically noted above, each of the remaining claims also constitute allowable subject matter based upon their dependence from independent claim 1 or an intervening claim. Any of these allowable dependent claims may, in fact, also include subject matter even more clearly not taught by the prior art, and Applicants reserve the right to argue such at a later date, if necessary. Therefore, in light of all of the above, Applicants respectfully request allowance of each and every one of the currently pending claims.

As it is believed that all of the rejections set forth in the Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

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If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By 

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